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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/373,585	08/13/1999	NOBUHIKO OGURA	Q55432	2737

7590

04/24/2002

SUGHRUE MION ZINN MACPEAK & SEAS  
2100 PENNSYLVANIA AVENUE N W  
WASHINGTON, DC 200373202

EXAMINER
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LU, FRANK WEI MIN

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 04/24/2002

16

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/373,585

Applicant(s)

OGURA, NOBUHIKO

Examiner

Frank Lu

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 25 March 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. **ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).**

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: \_\_\_\_\_.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☒ Other: See Advisory Action

  
CHANTAE DESSAU  
PATENT ANALYST

Frank Lu  
Examiner  
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### ADVISORY ACTION

1. Applicant's response filed on March 25, 2002 has been fully considered and has been entered. However, the arguments in applicant's remarks are not persuasive toward the withdrawal of the rejection. The claims pending in this application are claims 6, 7, and 14-21.

#### *Response to Arguments*

I. In page 1, last paragraph bridging to page 2 of applicant's remarks, applicant argued that: (1) "the examiner has failed to give due consideration to the fact that claim 6 describe a conveyor which conveys the plurality of applicators or sheet-like substrate relative to each other in a second direction while the applicators apply the plurality of known specific binding agent."; (2) the examiner "does not address prior arguments that the relative movement of Marston does not occur during application of the binding agents to the substrate and would not be modified to include such a feature.

These arguments have been fully considered but they are not persuasive toward the withdrawal of the rejection. Matson *et al.*, did describe "a conveyor which conveys the plurality of applicators or sheet-like substrate relative to each other in a second direction". For an example, they taught that a parallel one-dimensional matrix or array of biopolymers could be formed at an angle to the previous array by rotating the applicator (considered as applicator here) with respect to the solid support material (see column 2). Positioning means for positioning the applicator (see columns 7 and 8, and claim 1) could be considered as a conveyor as described in claim 6. The relative movement "while the applicators apply the plurality of known specific binding agent" and "during application of the binding agents to the substrate" as recited in claim

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6 was considered as an intended use of apparatus taught by Matson *et al.*. Note that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. *In re Casey*, 152 USPQ 235 (CCPA 1967); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

II In page 2, first paragraph of applicant's remarks, applicant argued that "the Federal Circuit decision in *In re Kotzab*, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) is more applicable" (the USPTO rejection was reversed) since "claim 14 describes a single axis of relative movement while the examiner admits that Stern teaches a multiple axes device."

This arguments has been fully considered but it is not persuasive toward the withdrawal of the rejection. First, the Federal Circuit decision in *In re Kotzab*, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) was not related to the rejection since the examiner did not cited this case law in previous rejection. Second, the situation in *In re Kotzab*, 55 USPQ2d 1313, 1317 was nonanalogous to claim 14 of this instant case because the Federal Circuit decision was based on "[E]vens does not teach or suggest the use of **a single temperature sensor to control a plurality of flow control valves**" (see page 6, second paragraph) while Stern *et al.*, disclosed a scanning system that could cause the exciting light to linearly scan the strip-like test piece along multiple axes (**Apple vs Orange**). Note that this system had a ability to cause the exciting light to

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**linearly scan the strip-like test piece along single axe during the scanning process (an intended use).**


2. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CAR § 1.6(d)). The CM Fax Center number is either (703) 308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Lu, Ph.D., whose telephone number is (703) 305-1270. The examiner can normally be reached on Monday-Friday from 9 A.M. to 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached on (703) 308-1152.

Any inquiry of a general nature or relating to the status of this application should be directed to the patent Analyst of the Art Unit, Ms. Chantae Dessau, whose telephone number is (703) 605-1237.

Frank Lu  
April 10, 2001



**ETHAN C. WHISENANT**  
**PRIMARY EXAMINER**